

REMARKS

In the Non-Final Office Action mailed on March 30, 2004 (Paper No. 6), the Examiner: rejected claims 22-24 and 34 under 35 U.S.C. § 101 as non-functional descriptive material; rejected claims 22-24 and 34 under 35 U.S.C. § 112, second paragraph, as being indefinite; and rejected claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,487,538 to Gupta et al. ("Gupta"). In this response, Applicants amend claims 22-24 and 34 and present new claims 38-51. Support for the claim amendments and the new claims are provided throughout the specification. The claim amendments and new claims add no new matter. As a result, claims 1-51 are pending. Applicants respectfully traverse the Examiner's rejections. Further examination and review in view of the amendments and remarks below are respectfully requested.

Applicants' Techniques

Applicants' techniques are directed to selecting a publisher's web site that is likely to produce good results for a particular advertiser if the advertiser places advertising there. In some cases, Applicants' technique evaluates candidate publishers based on the assessments of their inclination and/or affinity. Both inclination and affinity have to do with the extent to which a particular pair of web sites is visited by the same users. Inclination measures the extent to which users that visit the advertiser's web site also visit a candidate publisher's web site. Affinity measures the extent to which users that visit a publisher web site on which the advertiser conducted a successful advertising campaign in the past also visit a candidate publisher web site.

Gupta

Gupta describes a technique for local advertising on the Internet. According to the described technique, Internet Service Providers (ISPs) or proxies owned by an ISP insert advertisements that are transmitted from a web host to a client. Alternatively, any entity may insert or replace an advertisement that is transmitted to a client.

I. Rejections under 35 U.S.C. § 101

The Examiner rejected claims 22-24 and 34 as non-functional descriptive material, in that the described data structure is "simply data file – no functional change occurs when an application program uses the structural data." Applicants respectfully disagree. Each of claims 22-24 and 34 are directed to a data structure stored on one or more computer memories that enables the selection of a candidate advertising outlet and, thus, imparts functionality. The courts have found such data structures that impart functionality when encoded on a computer-readable medium to be statutory subject matter. See e.g., *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory); *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (claim to computer having a specific data structure stored in memory held statutory product-by-process claim).

II. Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 22-24 and 34 as being indefinite for including the phrase "such that the contents of the data structure may be used." Claims 22-24 and 34 have been amended to address the Examiner's concerns.

III. Rejections under 35 U.S.C. § 103

Claims 1-37 stand rejected over Gupta. Applicants respectfully traverse this rejection. With reference to claims 1-24, 36 and 37, each of the claims includes the feature of using an inclination metric to determine the desirability of placing with an electronic publisher an advertising message for an advertiser. The inclination metric is determined by processing information regarding the number of users that visit the advertiser and the number of users that visit the publisher.

In rejecting claims 1-24, 36 and 37, the Examiner conceded that Gupta does not explicitly teach the inclination metric. With specific reference to independent claim 1, the Examiner admitted that "Gupta does not expressly teach: dividing the count for the electronic publisher by the number of unique selected identifiers to obtain an indication metric for the electronic publisher; analyzing the inclination metrics obtained for the

electronic publishers; and selecting one or more of the electronic publishers on which to place an advertising message for the advertiser based upon the analysis." But, the Examiner stated that:

[I]t would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a particular advertiser would use the Gupta system to collect, track and store user's on-line behavior and would use this stored data to determine how successful the placement of a particular advertisement in a particular Internet Publisher would be, in comparison of placing the same advertisement in a different Internet Publisher. For example, if a particular advertiser places a particular advertisement in Publisher A and in Publisher B, and if 100 visitors visit Publisher A and 100 visitors visit Publisher B. Then suppose, that 75 visitors click-through to the particular advertiser's website in Publisher A but only 5 visitors click-through to the advertiser's website in Publisher B. Then, it would be obvious by using simple mathematics, such as dividing one number by another, that Publisher A would rank higher than Publisher B, in placing that particular advertisement for that particular advertiser. Therefore, it would be obvious that Gupta would track and store the online activities of the users and would use this store data to determine which publisher would do better than others in placing particular advertisements.

With specific reference to independent claim 2, the Examiner admitted that "Gupta does not expressly teach generating for the candidate advertising outlet a metric that compares the number of identified users to the number of counted users and constitutes a measure of the desirability of placing with the candidate advertising outlet one or more advertising messages for the selected advertiser." But, the Examiner went on to state "[h]owever, as explained in claim 1, Gupta would track and store the online activities of the users and would use this store data to determine which publisher would do better than others in placing particular advertisements." The Examiner rejected independent claims 22-24, 36 and 37 in similar fashion.

Applicants respectfully disagree. According to the Examiner's provided example, Gupta would track and store click-through data, and use the click-through data to determine which publisher would do better than others in placing particular advertisements. The click-through data is an indication of a "referral" from one web site to another in that a user at a first web site clicks-through to a second web site. In contrast, Applicants' technique utilizes inclination data, which is different than referral data, to determine the desirability of placing with an electronic publisher an advertising message for an advertiser. Inclination can be thought of as "co-visits" in that it is a

measure of the extent to which users that visit the advertiser's web site also visit a candidate publisher's web site, which is different than a click-through. Thus, in contrast to the Examiner's indication, it would not have been obvious to a person of ordinary skill in the art at the time the application was made to use the Gupta system to determine the desirability of placing with an electronic publisher an advertising message for an advertiser as claimed in claims 1-24, 36 and 37.

With reference to claims 25-35, the Examiner rejected these claims by applying the same reasons for rejecting claims 1 and 2. Applicants respectfully disagree. Each of the claims includes the common feature of using an affinity metric, alone or in combination with an inclination metric, to determine the desirability of placing with an electronic publisher an advertising message for an advertiser and, as such, includes elements that are different than the elements recited in either of claims 1 and 2. By applying the same reasons for rejecting claims 1 and 2 to claims 25-35, the Examiner has failed to show how Gupta discloses, suggests or teaches all the elements recited in claims 25-35. Likewise, Applicants find in Gupta no such disclosure, suggestion or teaching.

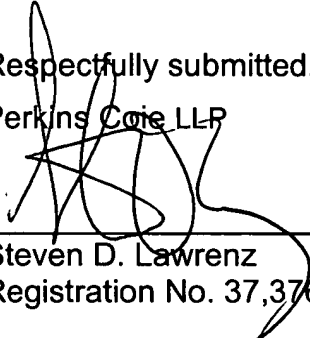
Each of newly added claims 38-51 depends from either claim 2 or claim 28, and recites elements that are neither taught nor suggested by Gupta.

IV. Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-51 are allowable and ask that this application be passed to allowance. If the Examiner has any questions or believes a telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned at (206) 359-8000.

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Respectfully submitted,
Perkins Coie LLP



Steven D. Lawrenz
Registration No. 37,376

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000